

**REMARKS**

**Claim Rejections**

Claims 1, 2, 4, 7-9, 11, 14 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by German Patent No. 200 00 079 to Heidorn. Claims 5, 6, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by the aforementioned reference to Heidorn taken in view of Torniainen et al. (U.S. 6,371,324). Claims 1, 2, 4, 7, 8, 9, 11, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by the aforementioned German patent to Heidorn taken in view of published PCT application no. WO 95/07847 to Schoenmakers et al. Claims 5, 6, 12 and 13 stand rejected under 35 U.S.C. §103(a) as being rendered obvious by the aforementioned combination of Heidorn in view of Schoenmakers taken further in view of the aforementioned patent to Torniainen.

**Drawings**

Applicant is submitting herewith formal drawings of Figs. 1-8, along with a Letter to the Official Draftsperson. Entry of these formal drawings is respectfully requested.

**Claim Amendments**

By this Amendment, Applicant has amended claim 1 and has canceled claims 9 and 11-15. Claim 1 has been amended to more specifically recite that the top cover wall has a single opening therethrough, as clearly disclosed in Applicant's original specification and drawings. No "new matter" is believed to have been added to the original disclosure by this amendment.

Applicant has attached hereto a certified translation of the German patent to Heidorn. Entry of the this document into the record of this case is respectfully requested.

**Rejection Under 35 U.S.C. § 102(b)**

Applicant respectfully traverses the Examiner rejection of claims 1, 2, 4, 7 and 8 as being anticipated by Heidorn. It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that Heidorn does not, in fact, disclose each and every feature of Applicant's structure as set forth in claim 1.

Specifically, Applicant submits that Heidorn does not disclose a top cover wall in a lid configured to be mounted on a food container wherein the top cover wall has a single opening therethrough, nor does this reference disclose a one-piece eating utensil located in the opening of the top cover having a food engaging portion "of substantially uniform thickness and an integral handle portion extending therefrom". It is further submitted that Heidorn does not disclose a side wall extending downwardly from a periphery of the top cover wall including first and second wall portions wherein the "second wall portion of one lid is configured to accept therein the first wall portion of another lid so as to enable a plurality of lids to be stacked in nested fashion", as specifically required by all of Applicant's claims.

It is abundantly clear that Heidorn does not, in fact, disclose a one-piece eating utensil of any type, but, rather, discloses a two-piece eating utensil having a food engaging portion and a handle portion that are separately formed and fastened together after they have been removed from the lid. This is typical of the known prior art. Clearly, Heidorn neither discloses a top cover wall having a single opening therethrough, nor a one-piece eating utensil as specifically required by Applicant's claims.

The Examiner stated, on page 2 of the outstanding Office Action that:

Wherein the spoon is molded with the lid and no specific teaching of variable thickness is set forth in the disclosure, it is inherent that the food engaging portion of the spoon is of "substantially uniform thickness".

Applicant respectfully traverses this contention. Simply put, the Examiner's conclusion is totally without any factual basis whatsoever. Heidorn does not include any figures illustrating the cross-section of the spoon and, as evident in the certified

translation attached hereto, contains no written description regarding any thickness of any part of the eating utensil. Applicant submits that there is absolutely no disclosure whatsoever in Heidorn regarding any thickness of the eating utensil and, therefore, the Examiner cannot rationally interpret this reference as “inherently” showing a food engaging portion of the spoon of substantially uniform thickness.

Heidorn is also totally devoid of any disclosure of the specific configuration of any side wall extending downwardly from the periphery of the top cover. Thus, this reference cannot be rationally interpreted as disclosing the features of this side wall as set forth in paragraph c) of Applicant’s claim 1. Clearly, there is no disclosure in Heidorn of any side wall structure that will “enable a plurality of lids to be stacked in nested fashion” as specifically required by all of Applicant’s claims.

In view of the foregoing deficiencies in the disclosure of Heidorn, Applicant submits that this reference could not rationally be interpreted as disclosing each and every feature of Applicant’s claim 1, from which all other claims remaining in this application depend. Absent the showing of these features in Heidorn, this reference cannot be said to anticipate Applicant’s claims 1, 2 and 4-8. This rejection is respectfully traversed.

#### **Rejections Under 35 U.S.C. § 103**

The Examiner cited the secondary reference to Torniainen as teaching a lid that is detachable from a food container having an eating utensil wherein the utensil can be a fork, knife, or spoon. Torniainen et al. clearly disclose the typical, well-known concept of a lid having a two-piece eating utensil comprising a food engaging portion and a handle portion that are affixed together once they have been removed from the lid. It is clear, from even a cursory review of Torniainen et al., that it does not disclose a top cover wall of a food container lid having a single opening therethrough, nor does it disclose a one-piece eating utensil as specifically required by all of Applicant’s claims. Additionally, there is no disclosure in Torniainen et al. that the lid has a side wall extending downwardly wherein a second portion of the side wall is configured to accept the first wall portion of another lid “so as to enable a plurality of lids to be stacked in nested fashion” as specifically required by all of Applicant’s claims. Thus, even if Torniainen et al. were combined with Heidorn, as

suggested by the Examiner, the resultant combination would also be totally devoid of all of these features. If none of the patents in a combination disclose Applicant's claimed features, it cannot be suggested that the combination of such references renders such features obvious. Applicant respectfully traverses the rejection of claims 5 and 6 as being rendered obvious by Heidorn taken in view of Torniainen.

The secondary reference to Schoenmakers was cited by the Examiner, in combination with Heidorn, to illustrate that it would have been obvious to modify Heidorn to include a one-piece eating utensil. Applicant submits that Schoenmakers does not show a one-piece eating utensil having a "food engaging portion of substantially uniform thickness" as specifically required by all of Applicant's claims. On page 5, lines 27 *et seq.* Schoenmakers specifically state:

The spoon 8 comprises a handle portion 16 and a bowl portion 17. The upper surface 18 of the spoon 8 is flat and flush with the flat upper surface 10 of the cover portion 2. A strengthening rib 21 is provided in the lower surface 19 of the spoon 8 and runs around the perimeter of the spoon 8. Another strengthening rib 23 extends across the spoon to define the border between the handle portion 16 and the bowl portion 17. ...

The lower surface of the bowl portion is of dished shape having a thinner central region at 24, and a thicker outer region at 25. [Emphasis added]

Clearly, the specific disclosure in Schoenmakers leads one having ordinary skill in the art away from the concept of providing a one-piece eating utensil having a good engaging portion "of substantially uniform thickness" as in Applicant's invention.

Schoenmakers is also totally devoid of any disclosure of a side wall extending downwardly from the periphery of the top cover having first and second wall portions wherein the second wall portion of one lid is configured to accept the first wall portion of another lid so as to "enable a plurality of lids to be stacked in nested fashion" as in Applicant's claims.

Since neither Heidorn, nor Schoenmakers disclose a one-piece eating utensil having a food engaging portion "of substantially uniform thickness", nor a second wall portion configured to accept a first wall portion so as to "enable a plurality of lids to be stacked in nested fashion", it is abundantly clear that the combination of these two references could not possibly render such features obvious. Applicant respectfully traverses the rejection of claims 1, 2, 4, 7 and 8 as being rendered obvious by Heidorn taken in view of Schoenmakers.

The aforementioned reference to Torniainen was applied along with the combination of Heidorn and Schoenmakers to reject Applicant's claims 5 and 6. Applicant respectfully traverses this rejection. As noted previously, the secondary reference to Torniainen does not disclose a one-piece eating utensil, nor does it disclose a side wall having the specific requirements of Applicant's claims. Thus, even if this reference was combined with Heidorn and Schoenmakers, the resultant combination would be devoid of the specific features required by Applicant's claims. Thus, it is submitted that this combination of references could not possibly render obvious Applicant's claims 5 and 6 under 35 U.S.C. § 103.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring

way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

More recently, the courts has held, in In re Fritch, 23 USPQ2d, 1780 (Fed.Cir. 1992), at page 1783 that:

The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Applicant submits that none of the references to Heidorn, Torniainen, or Schoenmakers contain the slightest suggestion that its teachings may be combined with the other as required by 35 U.S.C. § 103. It is believed to be abundantly clear that the Examiner has taken selected portions of three references, none of which contains the slightest disclosure that their teachings could be so combined, in a classic case of hind-sight reconstruction having the benefit of Applicant's disclosure. Clearly, such a combination is not an acceptable combination under 35 U.S.C. §103. The rejections of Applicant's claims as being rendered by the aforementioned combinations of references under 35 U.S.C. § 103 is respectfully traversed.

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**Summary**

In view of the foregoing amendments and remarks, Applicant submits that claims 1, 2, and 4-8 are now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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